



146.1374

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: : P.A. Duffy  
LALANNE et al :  
Serial No.: 09/980,054 : Group: 1645  
Filed: February 15, 2002 :  
For: NOVEL...THESE GENES :

475 Park Avenue South  
New York, N.Y. 10016  
June 10, 2004

**PETITION TO THE COMMISSIONER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby request the Commissioner of Patents and Trademarks to exercise his supervisory authority and direct the Examiner to examine the present claims in the application.

In the office action of December 4, 2003, the Examiner deemed that there was allegedly 19 different inventions present in the application and that there was a lack of unity between the various allegedly 19 different inventions.

In responding thereto, Applicants pointed out that there had been a lack of unity declared during the international procedure but not that there was 19 different inventions. The EPO, which acted as the international preliminary examination authority, found that the group of invention 5 as declared by the EPO in the international preliminary

06/17/2004 FFANAI2 00000098 09980054

01 FC:1460

130.00 0P

examination report (corresponding to claims 1 to 27 as filed in part) and which is directed to a polynucleotide with the sequence SEQ ID No: 11, analogs and fragments thereof; vectors and transformed host cells and the use thereof to product polypeptides; a plasmid I-2212 contained said polynucleotide (a polynucleotide with the SEQ ID No: 12, pCaNL260, and analogs and fragments thereof; the use thereof and a method for screening for anti-fungal products) and the use of the resulting products; antibodies directed against the polypeptide and the antibody and the diagnostic and therapeutic methods; kits for diagnosing fungal inventions forms a general inventive concept. This group of the EPO corresponds to groups 5 + 11 + 18 of the groups defined by the American Examiner.

Applicants are of the opinion that the Examiner is misinterpreting Rule 13 of the PCT Rules and that the present application deals with only six inventions as declared by the EPO during the international phase and not 19 separate inventions. Applicants' present claims deal with a plurality of inventions linked so as to form a single general inventive concept in line with the EPO's view.

The European Patent Office has conducted the international search and the international preliminary examination report based upon group 5 of the preliminary examination which corresponds to the present claims. Group 5 has been recognized to deal with a plurality of inventions linked so as to form a single general inventive concept

and the present claims should therefore be recognized to deal with a plurality of invention linked to form a single general inventive concept under the provisions of Rule 13.1 of the PCT Rules.

Moreover, the office action is dealing with election/restrictions and Applicants do not understand this since according to the MPEP, section 1893.03(d), "Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapters I and II and in national stage) filed under 35 USC 371 applications. Restriction practice continues to apply to U.S. national applications filed under 35 USC 111(a)." The present application has been filed under 35 USC 371 and therefore, the issue should be unity of invention and not restriction.

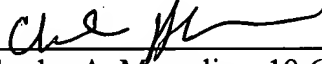
Applicants are of the opinion that the Examiner is misinterpreting Rule 13 of the PCT Rules and believes that the present set of claims deals with a group of inventions linked to form a single general inventive concept as defined by Rule 13. As stated in the MPEP, 1893.03(d), "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "special technical features" is defined as meaning those technical features that define the contribution which each claimed invention considered as a whole makes over the prior art."

The Examiner has made a particular group drawn to a polypeptide encoded by the DNA sequences of the present invention. In Applicants' opinion, the claims drawn to polypeptides, claims 44 and 45, should be in a single group as forming a group of inventions linked to form a single general inventive concept. It is clearly stated in Section 1850 of the MPEP that "Further, claims directed to the selected sequences will be examined with claims drawn to any sequence combinations which have a common technical feature with the selected sequences. Nucleotide sequences encoding the same protein are considered to satisfy the unity of invention standard and will continue to be examined together." This is also consistent with Section 803.04 of the MPEP.

Claims 40 to 44 as amended have been acknowledged to be in the same general inventive concept as claims drawn to DNA. Claims 45 and 46 are drawn to antibodies directed against a polypeptide of claim 34 or 35. The antibodies of claims 45 and 46 clearly share structural and functional features with claims 30 to 36 as they are directed against the polypeptide of claims 34 and 35 as required by Rule 13 of the PCT Rules and the recognized polypeptides of claims 34 and 35. Therefore, it is deemed that the remaining claims should be all examined in the same application.

Therefore, the Commissioner of Patents and Trademarks is respectfully requested to grant Applicants' petition and direct the Examiner to examine claims 30 to 46 in the same application.

Respectfully submitted,  
Muserlian, Lucas and Mercanti

  
\_\_\_\_\_  
Charles A. Muserlian, 19,683  
Attorney for Applicants  
Tel.# (212) 661-8000

CAM:ds  
Enclosures